

Remarks/Arguments

This Amendment is in response to the Office Action mailed July 28, 2004. Claims 1-20 were pending in this case at the time of the last Action. Claims 1-20 were rejected. Claims 1-4, 9-14 and 16-18 have herein been amended. Claims 5-7 and 19-20 have herein been canceled. Claims 8 and 15 remain unchanged. New Claims 21-32 have herein been added.

Claims 1-4, 9-10, 12-13 and 16 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery et al. (US 6,073,125) in view of Pickering Jr. et al. (US 6,557,755). For the following reasons, the Examiner's rejection is respectfully traversed.

The proposed combination does not make obvious Applicants' Claims 1-4, 9-10, 12-13 and 16 under 35 U.S.C. 103(a). Cordery et al., unlike Applicants' method for providing traceability of mail pieces, relates to a "mail payment and evidencing systems and, more particularly, to a token key distribution system for mail payment and evidencing system." (See Col. 1, lines 6-9). In other words, Cordery et al. relates to mail payment systems, and is concerned with verifying payment and preventing counterfeit postage. (See Col. 2, lines 58-62). Cordery et al. is not concerned with source identification of mail pieces for mail security and traceability, as

in Applicants' disclosed embodiments. Claims 1-4, 9-14 and 16-18 have been amended to clarify the same.

Accordingly, with respect to amended Claim 1, the proposed combination does not teach, disclose or suggest a method for providing traceability of mail pieces, or providing a tracing code on each of the plurality of mail pieces and on a mailing statement corresponding to a source of the mail pieces.

Cordery et al. relates to mail payment verification systems, and the digital token key K_m is not a tracing code used for tracing purposes. Further, as admitted in the Office Action, Cordery et al. fails to teach or fairly suggest that the "codes" of Cordery et al. correspond to a source of the mail piece.

Similarly, Pickering Jr. et al., which is assigned to the assignee of the present application, does not relate to a method for providing traceability of mail pieces, or providing a tracing code on each of the plurality of mail pieces and on a mailing statement corresponding to a source of the mail pieces. Instead, Pickering Jr. et al. relates to methods and systems for tracking and controlling mail piece processing, referring to operations performed on a mail piece, such as sorting and inserting. (See Col. 1, lines 7-24). Specifically, as discussed in the Summary of the Invention of Pickering Jr. et al. (Col. 2, lines 20-39), an existing postal

service mail piece code, such as the USPS PLANET code or the USPS POSTNET code, is used to control mail piece processing before it enters the mail stream (see Col. 8, line 63 to Col. 10, line 4), and for tracking the location of the mail piece both before and after it enters the mail stream (see Col. 10, line 5 to Col. 11, line 16).

Neither Cordery et al. or Pickering Jr. et al. teaches, suggests, discloses or even relates to using tracing codes corresponding to a source of a mail piece to provide traceability of mail pieces. The "codes" in both cited references are used in a very different manner for a very different function and purpose than the tracing codes of Applicant. As such, Pickering Jr. et al. fails to make up for the deficiencies of Cordery et al. Accordingly, for the reasons discussed above, the proposed combination fails to make obvious Applicants' Claim 1.

With respect to amended Claim 2, the proposed combination does not teach, disclose or suggest reading and verifying a tracing code on the mail pieces and the mailing statement. As discussed above, neither cited reference teaches, discloses or suggests the use of a tracing code.

With respect to amended Claim 3, the proposed combination does not teach, disclose or suggest that a first tracing code is

encrypted. As discussed above, neither cited reference teaches, discloses or suggests the use of a tracing code.

With respect to amended Claim 4, the proposed combination does not teach, disclose or suggest a tracing code embedded into a digital image, a text, a watermark, paper fibers or invisible ink. As discussed above, neither cited reference teaches, discloses or suggests the use of a tracing code.

With respect to amended Claim 9, the proposed combination does not teach, disclose or suggest passing each mail piece through tracing code producing equipment. As discussed above, neither cited reference teaches, discloses or suggests the use of a tracing code.

With respect to amended Claim 10, the proposed combination does not teach, disclose or suggest a tracing code independent from a meter imprint. As discussed above, neither cited reference teaches, discloses or suggests the use of a tracing code. Further, Cordery et al.'s digital token key is not independent from a meter imprint (see Claim 1, Col. 6, lines 59-62, wherein the encrypted indicium is generated by a meter).

With respect to amended Claim 12, the proposed combination does not teach, disclose or suggest a method for providing traceability of mail pieces; or providing an encrypted source tracing code on each of the plurality of mail pieces, reading the source tracing code,

verifying that the source tracing code corresponds to the source of the mail pieces, and then creating a mailing statement having a corresponding source tracing code. As discussed above, neither cited reference teaches, discloses or suggests the use of a tracing code. Further, neither cited reference performs a source verification step prior to creating the mailing statement.

With respect to amended Claim 13, the proposed combination does not teach, disclose or suggest reading and verifying a tracing code on the mail pieces and the mailing statement. As discussed above, neither cited reference teaches, discloses or suggests the use of a tracing code.

With respect to amended Claim 16, the proposed combination does not teach, disclose or suggest a tracing code independent from a meter imprint. As discussed above, neither cited reference teaches, discloses or suggests the use of a tracing code. Further, Cordery et al.'s digital token key is not independent from a meter imprint (see Claim 1, Col. 6, lines 59-62, wherein the encrypted indicium is generated by a meter).

For the above reasons, Applicants respectfully submit that the proposed combination does not make obvious Applicants' Claims 1-4, 9-10, 12-13 and 16 as set forth herein, and that those claims are allowable over Cordery et al. in view of Pickering Jr. et al. It is

respectfully requested that the Examiner reconsider and remove the above stated rejection.

Claims 5 and 14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery et al. as modified by Pickering Jr. et al. as applied to Claim 1 above, and further in view of Leon (US 20030028497).

Claims 6 and 14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery et al. as modified by Pickering Jr. et al. as applied to Claim 1 above, and further in view of Parkos (US 5,912,682).

Claims 7 and 14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery et al. as modified by Pickering Jr. et al. as applied to Claim 1 above, and further in view of Berson (US 5,929,415). It is note that Claims 5-7 have been canceled, and their subject matter incorporated into Claim 4.

For the following reasons, the Examiner's rejections are respectfully traversed. The proposed combinations do not make obvious Applicants' amended Claims 4 and 14 under 35 U.S.C. 103(a). The primary references Cordery et al. and Pickering Jr. et al. fail to make obvious amended Claims 1 and 12 for the above stated reasons.

Each of the cited secondary references fails to make up for the deficiencies of Cordery et al. and Pickering Jr. et al. with respect

to amended Claims 1 and 12. As such, the proposed combinations fail to render Claims 4 and 14 obvious.

Further, Leon is being cited to show the use of a watermark barcode. However, Leon relates to authenticating postage labels, and is concerned with the prevention of fraud in the printing of postage labels. None of the cited references are concerned with source tracing codes for mail security and traceability, and thus the required teaching or suggestion for the proposed modification under 35 U.S.C. §103 cannot be found in any of the cited references. The proposed combination fails to meet the limitation of a source tracing code being embedded into a watermark. As such, the proposed combination fails to make obvious Applicants' Claims 4 and 14.

Parkos is being cited to teach that "*postage indicia 10' is embedded into paper fibers.*" However, Parkos relates to printing a postage meter indicia using inks having certain characteristics such as being water fast. While the ink in Parkos is absorbed into the fibers of the envelope to be water fast, there is no teaching or suggestion in Parkos to embed a source tracing code into the paper fibers. None of the cited references are concerned with source tracing codes for mail security and traceability, and thus the required teaching or suggestion for the proposed modification under 35 U.S.C. §103 cannot be found in any of the cited references. The

proposed combination fails to meet the limitation of a source tracing code being embedded into paper fibers. As such, the proposed combination fails to make obvious Applicants' Claims 4 and 14.

Berson is being cited to teach that "a barcode 31 is invisible." However, Berson relates to a postage metering refill system that utilizes information contained in information based indicia to audit the franking process. None of the cited references are concerned with source tracing codes for mail security and traceability, and thus the required teaching or suggestion for the proposed modification under 35 U.S.C. §103 cannot be found in any of the cited references. The proposed combination fails to meet the limitation of a source tracing code being embedded into invisible ink. As such, the proposed combination fails to make obvious Applicants' Claims 4 and 14.

Claims 8, 11, 15 and 17-20 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Cordery et al. as modified by Pickering Jr. et al. as applied to Claim 1 above, and further in view of Pintsov (US 6,009,416). It is noted that in view of the amendment to Claim 18, Claims 19-20 have been canceled.

For the following reasons, the Examiner's rejection is respectfully traversed. The proposed combination does not make obvious Applicants' Claims 8, 11, 15 and 17-20, as set forth above,

under 35 U.S.C. 103(a). The primary references Cordery et al. and Pickering Jr. et al. fail to make obvious amended Claims 1, 12 and 18 for the above stated reasons. Pintsov fails to make up for the deficiencies of Cordery et al. and Pickering Jr. et al. with respect to amended Claims 1, 12 and 18. As such, the proposed combinations fail to render Claims 8, 11, 15, 17 and 18 obvious.

Further, Pintsov is being cited to show that a mailer's identity (name, address, telephone, banking account, etc.) is recorded, and that a suitable investigation can be implemented when data is inconsistent. However, Pintsov relates to a system and method for detection of errors in accounting for postal charges in controlled acceptance environment. None of the cited references are concerned with source tracing codes for mail security and traceability, and thus the required teaching or suggestion for the proposed modification under 35 U.S.C. §103 cannot be found in any of the cited references. As such, the proposed combination fails to make obvious Applicants' Claims 8, 11, 15 and 17-20.

Further, with respect to Claims 8 and 15, Pintsov does not capture and record the identity of an individual submitting the mail pieces. As described in Applicant's disclosure, the identity of the actual person submitting the mail, i.e., the person bringing the mail to the postal service facility, is captured by recording equipment,

such as a camera, video equipment, etc. To the contrary, Pintsov merely provides data on the mailing statement relating to the mail producer, and does not capture the identity of the individual submitting the mail.

With respect to amended Claims 11 and 17, Pintsov does not teach, disclose or suggest providing an alert indication. Conducting a suitable investigation is not the same as providing an alert indication. The suitable investigation could occur days, weeks or even months after the mail pieces are processed.

With respect to amended Claim 18, neither Pintsov nor the proposed combination teaches, discloses, or suggests capturing and storing the identity of an individual submitting the mail piece, as discussed above, or providing a source tracing code on the mail piece after the mail piece has been submitted to the postal facility, and storing information produced by the source tracking code producing equipment in association with the captured and stored identity of the individual submitting the mail piece.

For the above reasons, Applicants respectfully submit that the proposed combination does not make obvious Applicants' Claims 8, 11, 15 and 17-18 as set forth herein, and that those claims are allowable over Cordery et al. as modified by Pickering Jr. et al. as applied to Claim 1 above, and further in view of Pintsov. It is respectfully

requested that the Examiner reconsider and remove the above stated rejection.

New Claims 21-32 have been set forth to further particularly point out and distinctly claim Applicants' method for providing traceability of mail pieces, as set forth therein.

Specifically, new independent Claim 30 claims a method for providing traceability of mail pieces, comprising the steps of providing an encrypted tracing code on at least one envelope; providing the at least one envelope having the encrypted tracing code to a mailer; recording the identity of the mailer in association with the encrypted tracing code; receiving the at least one envelope at a postal service facility; and reading the encrypted tracing code on the at least one envelope to verify the source of the envelope.

New Claims 21, 24 and 27 claim that the step of capturing and storing the identity of an individual comprises the step of recording at least one physical characteristic of the individual. New Claim 22 claims that this recording is done via camera equipment, video equipment, finger print equipment or retina scan equipment. New Claims 23, 25, 28 and 31 claim the step of using the tracing code to trace the mail piece back to the individual submitter. New Claims 26, 29 and 32 claim the step of tracing the tracing code back to the source or mailer when the tracing code(s) do not correspond or cannot

be verified. For the above reasons, it is respectfully submitted that these new claims are likewise patentable over the prior art of record.

It is respectfully submitted that none of the prior art of record, either alone or in combination, fairly teaches, suggests or discloses the novel and unobvious features of Applicants' claimed invention. Accordingly, Applicants respectfully assert that the claims as presented herein are now in condition for allowance. An early notice allowance is respectfully requested.

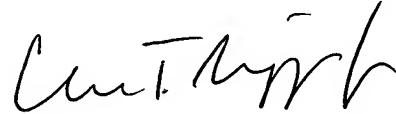
Any arguments of the Examiner not specifically addressed should not be deemed admitted, conceded, waived, or acquiesced by Applicants. Any additional or outstanding matters the Examiner may have are respectfully requested to be disposed of by telephoning the undersigned.

A Petition for an Extension of Time is enclosed along with a form PTO-2038 authorizing a credit card charge to cover the extension fee, and the fee for seven claims in excess of twenty, including one additional independent claim. The Commissioner is hereby authorized to charge any additional or deficient fees which may be required, including if necessary the above fee if there is any problem with the credit card charge, to Deposit Account No. 16-0657.

A postcard is enclosed evidencing receipt of the same.

Respectfully submitted,

PATULA & ASSOCIATES, P.C.

A handwritten signature in cursive script, appearing to read "C. T. Riggs Jr.", written in dark ink.

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